



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael L. Denby)
Serial No.: 09/546,502) Ex: ROWEN
Filed: 11 April 2000) Art Unit: 3643
For: FISHING LINE AND LURE)
CONNECTORS)

TRANSMITTAL OF SUPPLEMENTAL APPEAL BRIEF

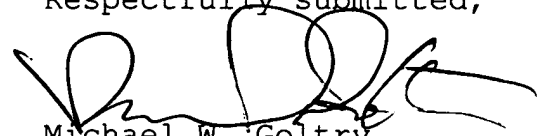
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

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Enclosed is a Supplemental Appeal Brief and two copies of the same, in compliance with the Rules, in the above captioned matter.

Respectfully submitted,


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27 January 2004

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Serial Number: 09/546,502
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In re application of:
Michael L. Denby

Serial No.:
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SUPPLEMENTAL APPEAL BRIEF FOR APPELLANT

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Alexandria, VA 22313-1450

Dear Sir:

In response to Appellant's appeal brief filed June 11, 2003, the Examiner in this case reopened prosecution and submitted a non-final Office Action, which was mailed on August 27, 2003, in which a shortened statutory period for response was set for 3 months, to and including November 27, 2003. Enclosed herewith please find a petition for a two-(2-) month extension of time accompanied with the appropriate fee. Rather than file a reply under 37 C.F.R. § 1.111, Appellant requests reinstatement of the appeal and consideration of this Supplemental Appeal Brief.

I. INCORPORATION BY REFERENCE

Appellant incorporates by reference the Appeal Brief filed June 11, 2003.

**II. ISSUES FOR REVIEW IN THE AUGUST 27, 2003, NON-FINAL
OFFICE ACTION**

1. Whether the invention claimed in claims 1-3 and 37 is obvious under 35 U.S.C. 103(a) as being unpatentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652).

2. Whether the invention claimed in claims 38-41 is obvious under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 4,864,767) in view of Drosdak (U.S. Patent 5,469,652).

III. ARGUMENT

A. Claims 1-3 and 37 are not obvious under 35 U.S.C. 103(a) as being unpatentable over in view of McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652).

Claims 1-3 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652). Appellant respectfully traverses Examiner's rejections of claims 1-3 and 37.

In the August 27, 2003, Office Action (paper no. 19), Examiner asserts that the patents to Drosdak '652 and McMahon show fishing line and lure connectors; that Drosdak '652 shows a line connector having a body 7 having a receptacle or socket 9 having inwardly directed extensions 10; that Drosdak '652 shows the body is capable of receiving the end segment of fishing line 6; that Drosdak '652 shows a coupler 8; that Drosdak '652 shows a first open end leading to a receptacle and a second

opposing end; that the patent to McMahon shows a connector having a body **a** and a coupler **b** attached to the body that is capable of engaging and supporting a fishing lure B, C; that the coupler is comprised of a pair of resilient hooks disposed in an overlapping state forming a continuous loop in which the lure part is engagable to the coupler by forcing the hooks apart; and that in reference to claims 1-3, 37, it would have been obvious to provide McMahon with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Examiner also asserts that the hooks would be attached to the second end of the body and that Drosdak '652 shows the extensions positioned at spaced intervals along substantially the entire length of the receptacle and also shows the extensions being directed away from an open end of the body.

In Drosdak '652, coupler 8 is a threaded female socket. With respect to claims 1-3 and 37, Examiner states that it would have been obvious to provide McMahon with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Appellant respectfully submits that this obviousness rejection of claims 1-3 and 37 is confusing, overly conclusory, unsupported by the prior art, lacks specificity, and that the Examiner is using hindsight and the teachings of Appellant's disclosure to improperly reconstruct the invention set forth in claims 1-3 and 37.

The Examiner states that it would be obvious to provide McMahon with a coupler as shown by Drosdak '652 and supports this conclusion not on the teachings of the prior art but on an overly broad and over-simplified conclusion

that one equivalent mechanical coupler is being substituted for another. Although the Examiner states that McMahan has a coupler b, the Examiner states that it would be obvious to provide McMahan with a coupler as shown by Drosdak '652, which, based on the language of the Examiner's rejection and his construction of the prior art, indicates replacing McMahan's coupler b with a threaded female socket of Drosdak '652. This does not make Appellant's claimed invention. Assuming, *arguendo*, that the Examiner concluded that it would have been obvious to provide coupler b of McMahan with threaded socket 8 of Drosdak '652, this obviousness rejection also fails as there is nothing in McMahan or Drosdak '652 that provides this suggestion or motivation.

Although the Examiner has identified in the prior art a coupler b as in McMahan and a threaded socket as in Drosdak '652, Examiner has not identified a teaching or suggestion in McMahan and/or Drosdak '652 to combine these elements as claimed and set forth by Appellant in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 is expressly for providing a coupling between a leader and a fly line, and that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line, Drosdak '652 teaches away from McMahan, McMahan does not provide any motivation to combine the teachings of Drosdak '652, and there is no teaching or suggestion in McMahan and/or Drosdak '652 to make the invention claimed by Appellant in independent claim 1 other than what is provided in Appellant's specification. Accordingly, Appellant respectfully asserts that the Examiner erred rejecting claims 1-3 and 37 as

obvious under 35 U.S.C. 103(a) as unpatentable over McMahon in view of Drosdak '652, that the combination of McMahon and Drosdak '652 is an improper combination, that the Examiner's section 103 rejection of claims 1-3 and 37 lack support in the prior art and also lack specificity, and that claims 1-3 and 37 are not obvious under section 103 as being unpatentable over McMahon in view of Drosdak '652.

The Examiner bears the burden of coming forward with evidence that supports the use of prior art references in combination. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998) (teaching, suggestion, or motivation to combine is an "essential evidentiary component of obviousness holding"); Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."); Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 959 (Fed. Cir. 1986) (Because virtually all inventions are combinations of old elements, the fact that invention at issue may be combination of known elements is irrelevant to the question of obviousness.). However, the Examiner has failed to establish sufficient information to support the requirement that the claimed invention would appear to have been obvious in view of the prior art, other than an overly conclusory, overly broad, unsupported, and over simplified statement that merely one equivalent mechanical coupler is being substituted for another.

The Examiner's rejection of claims 1-3 and 37 is not only overly broad and overly conclusory, it is also not at

all specific as to how one of ordinary skill in the art would have found it obvious to practice Appellant's claimed apparatus within the scope of Appellant's claims as of the filing date of Appellant's application subject to appeal. The Examiner has failed to establish a prima facie case of obviousness with McMahan and Drosdak '652. In fact, the only possible source or suggestion to combine McMahan with Drosdak '652 comes from Appellant's patent application. The Examiner cannot use Appellant's patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. See ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 221 USPQ 929, 933 (Fed. Cir. 1984); In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (both the suggestion and reasonable expectation of success must be found in the prior art, and not in the applicant's disclosure). Furthermore, the mere fact that McMahan may be modified by Drosdak '652 in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification, which it does not. McMahan and Drosdak '652 fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner.

Rather than making an appropriate and well-reasoned obviousness rejection of claims 1-3 and 37, the Examiner is attempting to construct an elephant from mouse parts because while perhaps some of the elements of the Appellant's claimed invention may be individually present in McMahan and Drosdak '652, none of these references suggest combining those elements in the manner that the Appellant has combined them. The Examiner has not shown that any of the prior art references including McMahan and/or Drosdak '652, taken

individually or together, suggest a motivation to combine the various elements as presently claimed by the Appellant.

B. Claims 38-41 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 5,469,652)

Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 4,864,767) Drosdak (U.S. Patent 5,469,652). Appellant respectfully traverses Examiner's rejections of claims 38-41.

In the August 27, 2003, Office Action (paper no. 19), Examiner asserts that the patents to Drosdak '767 and '652 show fishing line and lure couplers; that Drosdak '652, as discussed above in section A, shows a first open end leading to a receptacle and an opposing second end; and that Drosdak '767 shows a coupler attached to a body 10-12 in which the coupler comprises a pair of opposing plates 14, 14' which are biased together and prongs 18, 20 carried by and between the plates capable of securing a hook eye of a lure. In reference to claim 38, Examiner asserts that it would have been obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 since merely one mechanically equivalent coupler is being substituted for another and the function is the same.

In Drosdak '652, coupler 8 is a threaded female socket. With respect to claim 38, Examiner states that it would have been obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Appellant respectfully submits that this obviousness rejection of claim 38 is confusing, overly

conclusory, unsupported by the prior art, lacks specificity, and that the Examiner is using hindsight and the teachings of Appellant's disclosure to improperly reconstruct the invention set forth in claim 38.

The Examiner states that it would be obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 and supports this conclusion not on the teachings of the prior art but on an overly broad and over-simplified conclusion that one equivalent mechanical coupler is being substituted for another. Although the Examiner states that Drosdak '767 has a coupler 14,14', the Examiner states that it would be obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652, which, based on the language of the Examiner's rejection and his construction of the prior art, indicates replacing McMahon's coupler 14,14' with a threaded female socket of Drosdak '652. This does not make Appellant's claimed invention. Assuming, *arguendo*, that the Examiner concluded that it would have been obvious to replace eyelet 12 of Drosdak '767 with threaded socket 8 of Drosdak '652, this obviousness rejection also fails as there is nothing in McMahon or Drosdak '652 that provides this suggestion or motivation.

Although the Examiner has identified in the prior art a coupler 14,14' as in Drosdak '767 and a threaded socket 8 as in Drosdak '652, Examiner has not identified a teaching or suggestion in Drosdak '767 and/or Drosdak '652 to combine these elements as claimed and set forth by Appellant in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 is expressly for providing a coupling between a leader and a fly line, and that connector 7 can have various shapes and styles so long

as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line, Drosdak '652 teaches away from Drosdak '767, Drosdak '767 does not provide any motivation to combine the teachings of Drosdak '652, and there is no teaching or suggestion in Drosdak '767 and/or Drosdak '652 to make the invention claimed by Appellant in independent claim 38 other than what is provided in Appellant's specification. Accordingly, Appellant respectfully asserts that the Examiner erred rejecting claims 38-41 as obvious under 35 U.S.C. 103(a) as unpatentable over Drosdak '767 in view of Drosdak '652, that the combination of Drosdak '767 and Drosdak '652 is an improper combination, that the Examiner's section 103 rejection of claims 38-41 lack support in the prior art and also lack specificity, and that claims 38-41 are not obvious under section 103 as being unpatentable over Drosdak '767 in view of Drosdak '652.

As previously stated in section A, supra, the Examiner bears the burden of coming forward with evidence that supports the use of prior art references in combination. See C.R. Bard, 157 F.3d at 1352; Arkie Lures 119 F.3d at 957; Custom Accessories, 807 F.2d at 959. However, the Examiner has failed to establish sufficient information to support the requirement that the claimed invention would appear to have been obvious in view of the prior art, other than an overly conclusory, overly broad, unsupported, and over simplified statement that merely one equivalent mechanical coupler is being substituted for another.

The Examiner's rejection of claims 38-41 is not only overly broad and overly conclusory, it is also not specific as to how one of ordinary skill in the art would have found

it obvious to practice Appellant's claimed apparatus within the scope of Appellant's claims as of the filing date of Appellant's application subject to appeal. In this regard, the Examiner has failed to establish a prima facie case of obviousness with Drosdak '767 and Drosdak '652. In fact, the only possible source or suggestion to combine Drosdak '767 with Drosdak '652 comes from Appellant's patent application. As previously stated in section A, supra, the Examiner cannot use Appellant's patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. See ACS Hosp., 221 USPQ at 933; In re Dow Chem. Co., 837 F.2d at 473. Furthermore, the mere fact that Drosdak '767 may be modified by Drosdak '652 in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification, which it does not. Drosdak '767 and Drosdak '652 fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner.

Rather than making an appropriate and well-reasoned obviousness rejection of claims 38-41, the Examiner, as with claims 1-3 and 37, is attempting to construct an elephant from mouse parts because while perhaps some of the elements of the Appellant's claimed invention may be individually present in Drosdak '767 and Drosdak '652, none of these references suggest combining those elements in the manner that the Appellant has combined them. The Examiner has not shown that any of the prior art references including Drosdak '767 and/or Drosdak '652, taken individually or together, suggest a motivation to combine the various elements as presently claimed by the Appellant.

C. Conclusion

Appellant assert that following claims on appeal are not obvious and not unpatentable and should be allowed:

1. Independent claim 1 and dependent claims 2, 3, and 37; and
2. Independent claim 38 and dependent claims 39-41.

It is respectfully submitted that Appellants' claims 1-3 and 37-41 are clearly allowable and that this case is in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

Michael L. Denby

A handwritten signature in black ink, appearing to read 'Michael W. Goltry', is written over the typed name.

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27 January 2004
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